REMARKS

INTRODUCTION

Claims 1-63 were previously pending and under consideration.

Claims 1-63 are rejected.

Claims 1, 56-58 and 63 are objected to.

Claims 1, 56, and 63 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

In the Office Action, at page 2, claims 1-3, 7-12, 56-58, 60 and 63 were rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth therein. Applicant respectfully notes Figure 3 and page 17, lines 4-22. It is very well known that hard disks contain file-systems of which directories are a part, as seen in Figure 3. Furthermore, "The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement" (MPEP 2163.02). Furthermore, newly added claim limitations may be supported "through express, implicit, or inherent disclosure" (MPEP 2163). Withdrawal of the rejection is respectfully requested.

CLAIM OBJECTIONS

Claims 1, 56-58 and 63 were objected to because of informalities. Appropriate corrections have been made. Withdrawal of the objection is requested.

REJECTIONS UNDER 35 USC § 103

In the Office Action, at pages 3-8, claims 1-63 were rejected under 35 U.S.C. § 103 as being unpatentable over Hsu in view of World Wide Web Consortium. This rejection is traversed and reconsideration is requested.

In view of the numerous issues raised below, Applicant respectfully notes that "The examiner must ... address any arguments presented by the applicant which are still relevant to any references being applied." Applicant requests a response to each argument below that remains relevant. If a new minor reference is added but Hsu is still relied on as the primary reference, then most if not all of the following arguments would remain relevant and would require a response from the Examiner.

(1)   PROPOSED MODIFICATION OF HSU WOULD CHANGE ITS THE PRINCIPLE OF OPERATION

MPEP 2143.01 states that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."

As shown above, the principle of operation in Hsu is to build product manuals "Based on the configuration specification of a product" (column 6, lines 39-42). Also, Hsu's principle of operation is to "assembl[e] product manuals based on a product model, a delivery model and a formal configuration specification" (Abstract, first sentence). For this purpose, Hsu provides a "Product Manual Configuration Specification Language (PMCSL), for the author to describe the logical structure of a product manual" (column 6, lines 31-37). Hsu has its own specific mode and principal for creating the structure of a document, namely, a user configuring the structure by hand to create a base of predetermined information that defines the document.

The rejection proposes modifying Hsu to structure a document based on or responsive to documents in a file-system directory. However, this would alter Hsu's principle of operation, which is to structure a document based on the configuration specification of a product (see item 216 in Figure 2).

The rejection is traversed because the proposed modification of Hsu would alter its basic mode of operation from a configuration-driven design to a directory-content driven design.

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(2)　NO MOTIVE TO MAKE PROPOSED MODIFICATION WHEN PROBLEM SOLVED
　　　THEREBY DOES NOT EXIST IN REFERENCE

The Examiner suggests modifying Hsu to include "storing, each time one of the plurality of non-structured documents to be included in the hub document format structured document is prepared or edited, the non-structured document into the original document file-system directory", as recited in claim 1, for example. This modification is traversed because it lacks a proper motivation. There can be no motive to make a modification to solve a problem when that problem does not exist. Hsu does not need the modification proposed by the Examiner because Hsu has its own approach to the problem of updating or editing documents. In Hsu, "The product manual composition process keeps track of the configuration of a product manual at the document object level in the configuration specification file and the tables in the document database ... the present invention supports incremental processing such that a product manual may be incrementally updated" (column 15, line 65, to column 16, line 2). The proposed modification does not make sense because Hsu already has a mechanism allowing incremental updating/editing of documents.

In sum, the Examiner has proposed a modification that Hsu does not need or benefit from. Withdrawal of the rejection is respectfully requested.

The proposed modification is also traversed because, as discussed below, the rejection did not, as required, take into account *all* of the teachings of Hsu, including those that go against the proposed modification.

(3)　PRIMA FACIE CASE OF OBVIOUSNESS NOT MADE; FAILURE TO CONSIDER
　　　PORTIONS OF HSU THAT LEAD AWAY FROM INCLUDING ENTITY/REFERENCE
　　　RESPONSIVE TO PRESENCE IN DIRECTORY

MPEP 2143.03 states that "A prior art reference **must** be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention", because "A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention" (MPEP 2143.05(III)).

The rejection is traversed because it fails to consider that Hsu discloses "a system and method for assembling product manuals automatically based on product models" (column 1, lines 12-14, emphasis added); the system of Hsu "automatically asembl[es] product manuals based on a product mode, a delivery model and a formal configuration specification" (column 2,

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lines 6-8), emphasis added. In other words Hsu has its own specific means for building up a hub document.

The Examiner acknowledges that "[Hsu does not teach] adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory". The Examiner proposes modifying Hsu to include this feature. However, in proposing this modification, the Examiner did not take into consideration the teachings of Hsu discussed above (and also discussed in Applicant's previous Amendment). In making a prima facie case of obviousness, the Examiner is required to consider *all teachings of the cited art*, including those that teach away from the proposed modification. Although required to, the Examiner has not taken into account teachings of Hsu that teach away from the proposed combination/modification. Applicant specifically explained before relevant teachings of Hsu, namely that "in Hsu the author determines what documents are to be included as part of the product manual by editing the configuration/specification information" (see page 15, first full paragraph of Applicant's previous Amendment). The Examiner has not disputed this characterization of the teaching of Hsu and apparently agrees.

By failing to consider all of the teachings of Hsu the Examiner has not met the requirements for making a prima facie case of obviousness. Withdrawal of the rejection is respectfully requested. Due to Applicant's previous emphasis on disclosures in Hsu that teach away from the proposed modification, any new rejection must be non-final.

(4) REJECTION IMPROPER: LIMITATIONS FOUND IN BODY OF CLAIM, NOT PREAMBLE

The Examiner denied patentable weight to "entity references" because it is purportedly found only in the preamble. The rejection is further traversed because "entity references" are found throughout the bodies of the claims. Claim 1's body, for example, recites "automatically adding entity declarations to the hub document ... by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations referring to the structured documents". The rejection is traversed and requested to be withdrawn because it expressly did not consider limitations in the bodies of the claims.

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(5)   IMPROPER RELIANCE ON PERSONAL KNOWLEDGE OF EXAMINER/OFFICIAL NOTICE

At page 9 of the Office Action, the Examiner states that "one of ordinary skill in the art would have recognized that basing a hub document on the entity declarations would have provided the benefit of flexible and efficient document production, allowing reuse of components in different documents and ensuring that the most up-to-date versions of components were used". However, the Examiner provides no prior art to support this assertion.

"Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. Assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art *must always* be supported by citation to some reference work recognized as standard in the pertinent art." In re Ahert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970). An "assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice").

The rejection must be withdrawn because the Examiner has "filled in gaps" in the rejection using the Examiner's personal knowledge (or Official Notice) rather than prior art of record. As stated in MPEP 2144.04(C), "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence". The Examiner's assertion is not well-known or common knowledge because "allowing reuse of components" and "ensuring that the most up-to-date version of components [are] used" can be achieved in many different ways; hub documents are an esoteric area of technology and means for implementing same are not common knowledge. Applicant requests the Examiner to either provide an affidavit or prior art that supports the assertion, or withdraw the rejection.

The Examiner also uses personal knowledge in suggesting modifying Hsu to include "storing, each time one of the plurality of non-structured documents to be included in the hub

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document format structured document is prepared or edited, the non-structured document into the original document file-system directory", as recited in claim 1, for example. The Examiner cites no art of record supplying a motivation for the particular modification proposed by the Examiner. Claim 1, for example, recites that a document is stored in the original document file-system directory each time it is edited. In claim 1 this makes sense because documents in that directory are converted to structured documents. However, nothing in Hsu suggests a need to take this measure (note Hsu is primarily about document assembly). In fact, as discussed elsewhere herein, Hsu has its own method of allowing incremental updates. Applicant respectfully requests the Examiner to provide documentary support for the assertion above, or withdraw the same.

(6)   REJECTION FAILS TO ADDRESS ALL LIMITATIONS OF THE CLAIMS

According to MPEP 2144.03, "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." MPEP 2106 states that, "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." As discussed below, the rejection is traversed because it fails to consider all of the words of the last element of claim 1, for example.

The last element of claim 1 recites automatically adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations referring to the structured documents. Note that an entity declaration is included by obtaining corresponding document names of the documents *stored in the* structured document *file-system directory*. In other words, this feature includes acquiring document names from a file-system directory.

Pages 3-6 of the Office Action address claim 1. The rejection addresses "acquiring document names of the structured documents and preparing corresponding entity declarations referring to the structured documents" (page 5, top). However, this part of the rejection does not mention or address *how* document names are acquired. The rejection also addresses "adding

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entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory" (page 5, first full paragraph). Applicant has carefully reviewed the Office Action and has found no mention by the Examiner of "automatically adding entity declarations to the hub document ... by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations". The rejection has not considered all of the words of claim 1, for example.

In sum, the rejection is traversed because it is incomplete. If the Examiner believes that the limitation of "automatically adding entity declarations to the hub document ... by acquiring document names of the structured documents stored in the structured document file-system directory and preparing corresponding entity declarations" has been addressed, Applicant respectfully requests the Examiner to indicate where in the Office Action it has been mentioned or addressed. Otherwise, Applicant requests withdrawal of the rejection. Any new rejection must be non-final.

Furthermore, Applicant notes that not all of the features of claim 63 have been examined. The rejection grouped claims 1, 49, 56, and 63 but only addressed the features of claim 1. As stated in MPEP 707.07(d), "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." From the bottom of page 3 to the top of page 6 the rejection addresses only features recited in claim 1. The rejection of claim 1, however, cannot be equally applicable to claim 63 because claim 63 recites features not found in claim 1. Claim 63 recites "when preparing the hub document, automatically responding to the presence of the unstructured document files in the pre-determined directory by converting the unstructured document files to corresponding structured document files, where structure of the structured documents is given by markup tags included therein". The rejection does not address this feature and it is not taught or suggested by the prior art. Claim 63 also recites "automatically acquiring a list of filenames of the respective structured document files in the pre-determined file-system directory, preparing corresponding entity declarations, and adding same to the hub document". The rejection does not address this feature. Claim 63 also recites that "but-for the presence of the structured documents in the pre-determined file-system directory they would not be referenced in the hub document and where the presence of the structured documents in the pre-determined file-system is what determines that they are to be

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referenced in the document directory". The Examiner has not addressed this feature, which is not found in claim 1. The current rejection of claim 1 is not equally applicable to claim 63.

In sum the rejection is further traversed for failure to establish a prima facie case of obviousness with respect to claim 63. The Examiner has not shown how the features of <u>claim 63</u> are found in the prior art. Applicant respectfully requests a new non-final Office Action addressing the features of claim 63, which are not the same as the features of claim 1.

(7)   <u>ADVANTAGE OVER PRIOR ART</u>

As stated in Hsu, "collecting all documents and engineering data for a new product may take an extended period of time" (column 16, lines 2-4). With claim 1, for example, a hub document can be prepared in short time with little effort. For example, a user may simply place files in an appropriate directory to create a corresponding hub document. Hsu does not have this advantage, even if modified as suggested. Withdrawal of the rejection is respectfully requested.

(8)   <u>PRIOR ART DOES NOT RESPOND TO PRESENCE OF DOCUMENTS IN A DIRECTORY</u>

The rejection acknowledges that "Hsu [does] not teach adding entity declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory" (page 5, lines 14-16). The rejection notes that *XML Schema Part I*, shows "a hub document based on the entity declarations regarding the structured documents". However, claim 1 recites adding declarations to the hub document responsive to the presence of the structured documents in the structured document file-system directory". As previously argued by Applicant, *XML Schema Part I* defines XML schemas but provides no teaching or suggestion on how to build an XML document.

Even the Examiner's unsupported assertions do not meet the recited feature of claim 1. The Examiner's personal knowledge teaching is only: "basing a hub document on entity declarations regarding the structured documents". However, this overlooks what claim 1 actually recites. Claim 1 recites <u>when</u> then entity declarations are obtained (responsive to presence of

documents in a directory), and in connection <u>how</u> the entity declarations are obtained (acquiring document names of documents stored in a directory). The rejection addresses only the static structure and content of a hub document. *XML Schema Part I* provides no guidance on how or when entity declarations can be automatically added. The rejection does not address the particular mechanism for building a hub document that is recited in claim 1, for example.

Applicant respectfully requests either withdrawal of the rejection or an explanation of where *XML Schema Part I* provides Hsu with the timing and means of automatically adding entity declarations as found in claim 1, for example, but not found in Hsu.

(9)   REJECTION FAILS TO ADDRESS CLAIMS AS A WHOLE

MPEP 2164.08 directs an examiner to " determine what each claim recites and what the subject matter is when the claim is <u>considered as a whole</u>, not when its parts are analyzed individually." In making a case of obviousness, the examiner must "evaluate the 'subject matter as a whole' of the invention." Claim 1, for example, recites a combination of features by which unstructured documents may be put in a directory and a hub document may result. The rejection does not consider the claims as a whole.

(10).   REJECTION INCONSISTENT

The rejection is inconsistent because it equates a "file-system directory" in the claims to both a database and a subdirectory. In the rejection, "a structured document file-system directory area" is compared to column 8, lines 16-18 of Hsu, which discloses a <u>document database</u>, not a file-system directory. According to the Examiner, the converted documents are stored in a database. The rejection also compares "storing them [i.e. structured documents] in the structured document storage file-system directory" to column 3, lines 20-44 of Hsu. However, this part of Hsu stores in a subdirectory rather than a database. Withdrawal of the rejection is requested.

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DEPENDENT CLAIMS

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 2 recites attached features are not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.
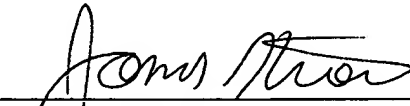
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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